

# Notice of Allowability

Application No.

09/721,096

Examiner

Yelena G. Gakh, Ph.D.

Applicant(s)

CHRISTENSEN ET AL.

Art Unit

1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to Interviews on 07/29/04 and 08/06/04.
2. ☒ The allowed claim(s) is/are 47,48,50-54,56-58 and 75-80.
3. ☒ The drawings filed on 22 November 2000 are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☐ All    b) ☐ Some\*    c) ☐ None    of the:
    1. ☐ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
  - \* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.  
**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
  6. ☐ CORRECTED DRAWINGS ( as "replacement sheets" ) must be submitted.
    - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review ( PTO-948) attached
      - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
    - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

## Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date 07/06/04
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☒ Interview Summary (PTO-413), Paper No./Mail Date 08/06/04
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_\_

### EXAMINER'S AMENDMENT

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with A. Blair Hughes on 08/06/04.

The application has been amended as follows:

**In the specification**, the sentence at page 13, lines 28-29: "in contrast, organic solvents, such as toluene, xylene, limonene, are ~~immiscible~~ miscible with paraffin and therefore considered suitable for deparaffinization".

**In the claims:**

Cancel **claims 49, 55 and 59-74.**

**Claim 47.** (Amended) A method of removing a paraffin based embedding medium from a biological sample, the method comprising the steps of:

loading a plurality of biological samples into an automated apparatus wherein the biological samples are embedded with a paraffin based embedding medium that includes infused media;

heating the biological sample containing paraffin based embedding medium to a temperature at or above the paraffin based embedding medium's melting point to form a liquefied paraffin based embedding medium; and

applying an liquefied paraffin based embedding medium immiscible liquid including a detergent to the biological sample to separate the liquefied paraffin based embedding medium from the biological sample; and

rinsing the separated liquefied paraffin based embedding medium from the biological sample with a rinsing liquid or gas such that essentially all of the paraffin based embedding medium, including infused media, is removed from the biological sample.

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In **claim 50** change [49] to -- 47 --;

In **claim 52** insert -- paraffin based -- before “ the embedding medium”;

**Claim 53.** (Amended) A method of removing paraffin based embedding medium from a biological sample, the method comprising the steps of:

loading a plurality of biological samples including a paraffin based embedding medium into an automated apparatus wherein the embedding medium includes infused media;

applying an liquefied paraffin based embedding medium immiscible liquid including at least one detergent to a biological sample embedded in a paraffin based embedding medium; and

heating the biological sample containing embedding medium to a temperature at or above the embedding medium's melting point thereby separating the liquefied paraffin based embedding medium from the biological sample with the immiscible liquid; and

removing the separated paraffin based embedding medium from the biological sample with a rinsing liquid or gas such that essentially all of the paraffin based embedding medium, including infused media, is removed from the biological sample.

In **claim 56** change [55] to -- 53 --.

The following is an examiner's statement of reasons for allowance: the potential closest prior art of Yörükoğlu submitted by the Applicants, which teaches a method of removing paraffin-based embedding medium from a cell sample by melting embedding paraffin away and transferring the tissue sample free of embedding material from one vessel to another, does not teach or fairly suggest using detergents in a paraffin immiscible liquid when separating the paraffin embedding material from the cell, and implying the step of deparaffinizing the sample in an automated apparatus.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled “Comments on Statement of Reasons for Allowance.”

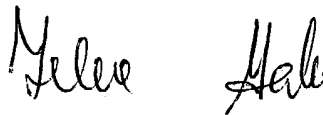
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yelena G. Gakh, Ph.D. whose telephone number is (571) 272-1257. The examiner can normally be reached on 9:30 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on (571) 272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Yelena G. Gakh  
8/9/04

A handwritten signature in cursive script, appearing to read 'Yelena Gakh', is positioned to the right of the typed name and date.